

### **REMARKS**

Applicants respectfully request entry of amendments to claims 1, 19, 22, 33, 37, 42, and 43. Claims 2-8, 12-14, 16-18, 20, 21, 23-25, 30, 34-36 were previously canceled.

Support for the amendments can be found throughout the specification, including page 17, ll. 8-20, page 59, ll. 25-31, and the originally filed claims and, therefore, do not add new matter.

Applicants submit that pending claims 1, 9-11, 15, 19, 22, 26-29, 31-33, 37, and 39-43 are in condition for allowance, and respectfully request that the claims as amended be entered.

### **Specification**

Applicants have amended to specification to update the status of the co-pending applications referenced therein.

### **Objection**

Applicants have provided herewith amended claims 1, 19, 22, 33, 37, and 42-43 according to the suggestion in the Action.

For these reasons, Applicants respectfully request that the objection be withdrawn.

### **Rejection Under 35 U.S.C. §102**

Claims 1, 9-11, 15, 19, 22, 27-29, 31-33, 39-40, and 42-43 stand rejected under 35 U.S.C. §102(b), as allegedly being anticipated by Barker et al.

Applicants traverse the rejection as it might apply to the amended claims, including claims dependent therefrom, for the reasons given below.

The Office Action alleges, in pertinent part, that because the effective date for the rejected claims is considered to be 27 July 2000, the cited reference teaches the elements as recited in the present claims. Applicants respectfully submit that the amended claims enjoy the priority date of at least the parent application.

The present claims expressly recite either "a core of hydrophobic amino acids" or "a promyostatin polypeptide, wherein said polypeptide regulates muscle cell growth." As expressly

recited in the 09/124,180 application (hereinafter, the '180 application) at page 44, first full paragraph, ll. 10-11, "The sequence contains a core of hydrophobic amino acids at the N-terminus . . .". As claimed, the encoded peptide of claim 1 is defined by specific amino acids residues in the N-terminus, where there is a concentration of amino acid residues that are hydrophobic. Further, this region containing these residues was indicative of a signal sequence (see, e.g., Figure 6a of the '180 application). As such, the elements of amended claim 1 (including claims dependent therefrom) enjoy the benefit of priority of the '180 application, and therefore, the Barker et al. reference does not apply.

Regarding the zebrafish and salmon species, piscine species were specifically recited in the '180 application (see, e.g., page 13, first full paragraph, l. 18 of the '180 application), and given the sequence homology observed between the various species of prepromyostatin, the '180 application should be considered to support priority for the piscine genus and zebrafish and/or salmon claim elements. Nevertheless, as the Action specifically states that the corresponding sequences encoding the zebrafish homolog of the instant application (i.e., SEQ ID NO:20) and Barker et al. (SEQ ID NO:36) are not the same (page 6, first paragraph, ll. 4-5), the reference does not teach this element of the claims. "It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention." Hybritech Inc. v. Monoclonal Antibody, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986), and because Barker et al. do not meet this standard, the reference does not anticipate the claims.

Further, as stated above, other claims recite "a promyostatin polypeptide, wherein said polypeptide regulates muscle cell growth." This element simply defines a property of the parent polypeptide, and there is no question that this property enjoys the benefit of priority of the parent. Moreover, as claims 26 and 41 are not rejected, statements in the Action regarding priority and amino acid ranges recited in the claims do not seem to be relevant.

Therefore, because the instant amended claims enjoy the priority of at least the parent application, and the cited reference does not meet the "all elements" standard, Barker et al. do not anticipate the invention as claimed.

For these reasons, Applicants respectfully request that the rejection be withdrawn.

**Rejections Under the Judicially Created Doctrine of Obviousness-Type Double Patenting**

Claims 1, 9-11, 15, 19, 22, 27-29, 31-33, 37, and 39-43 stand rejected under the judicially created doctrine of obviousness double patenting allegedly over claims 2-11 of U.S. Patent No. 5,827,733.

While not acquiescing to the reasoning offered in the Office Action, and to expedite prosecution toward allowance, Applicants have provided herein a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c).

For this reason, Applicants respectfully request that the rejection against claims 1, 9-11, 15, 19, 22, 27-29, 31-33, 37, and 39-43 be withdrawn.

Claims 19, 22, 27-29, and 32 stand rejected under the judicially created doctrine of obviousness double patenting allegedly over claims 1-11 of U.S. Patent No. 6,500,664.

While not acquiescing to the reasoning offered in the Office Action, and to expedite prosecution toward allowance, Applicants have provided herein a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c).

For this reason, Applicants respectfully request that the rejection against claims 19, 22, 27-29, and 32 be withdrawn.

Claims 1, 9-11, 19, 26, 32-33, and 39-41 stand rejected under the judicially created doctrine of obviousness double patenting allegedly over claims 1-14 of U.S. Patent No. 6,465,239.

While not acquiescing to the reasoning offered in the Office Action, and to expedite prosecution toward allowance, Applicants have provided herein a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c).

For this reason, Applicants respectfully request that the rejection against claims 1, 9-11, 19, 26, 32-33, and 39-41 be withdrawn.

Claims 1, 9-11, 15, 19, 22, 27-29, 31-33, 37, and 39-40 stand provisionally rejected under the judicially created doctrine of obviousness double patenting allegedly over claims 21-30 of co-pending U.S. Application Ser. No. 10/997,809.

In re Application of:

Lee and McPherron

Application No.: 09/807,693

Filing Date: November 7, 2000

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While not acquiescing to the reasoning offered in the Office Action, and to expedite prosecution toward allowance, Applicants have provided herein a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c).

For this reason, Applicants respectfully request that the provisional rejection against claims 1, 9-11, 15, 19, 22, 27-29, 31-33, 37, and 39-40 be withdrawn.

In re Application of:  
Lee and McPherron  
Application No.: 09/807,693  
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**Conclusion**

Applicants submit that pending claims 1, 9-11, 15, 19, 22, 26-29, 31-33, 37, and 39-43 are in condition for allowance. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this submission.

A check in the total amount of \$65.00 is enclosed as payment for the Terminal Disclaimer fee (\$65.00) for small entity. No other fee is deemed necessary with the filing of this paper. However if any fees are due, the Commissioner is hereby authorized to charge any fees, or make any credits, to Deposit Account No. 07-1896 referencing the above-identified attorney docket number. A duplicate copy of the Transmittal Sheet is enclosed.

Respectfully submitted,

Date: October 23, 2006

  
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Lisa A. Haile, J.D., Ph.D.  
Registration No. 38,347  
Telephone: (858) 677-1456  
Facsimile: (858) 677-1465

DLA Piper US LLP  
4365 Executive Drive, Suite 1100  
San Diego, California 92121-2133  
**USPTO Customer Number 28213**